

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
Edward L. Beery II) Group Art Unit: 1751
Serial No.: 09/954,823) Examiner: Nguyen, Tri V.
Filing Date: September 18, 2001) Confirmation No.: 8192
For: System for Delivery of Promotional Savings

APPEAL BRIEF

To: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in response to the final rejections of the claims mailed July 18, 2006. The Notice of Appeal fee was paid with the Notice of Appeal filed October 6, 2006.

REAL PARTY IN INTEREST

The assignee of the entire right, title, and interest in the patent application is Edward L. Beery II.

RELATED APPEALS AND INTERFERENCES

There are currently no related appeals of other United States patent applications known to Appellants, Appellants' legal representative, or the assignee that will directly affect, or be directly affected by, or have a bearing on, the Board's decision. There are currently no related interferences known to Appellants, Appellants' legal representative, or the assignee which will directly affect, or be directly affected by, or have a bearing on, the Board's decision.

STATUS OF CLAIMS

Claims 9-28 are pending in the application. Claims 1-8 were canceled in the Amendment filed May 4, 2006. In the final Office Action mailed July 18, 2006, claims 9-23, 25, 26, and 28 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,055,513 to Katz, et al (hereinafter, "Katz"). Claims 24 and 27 were rejected under 35 U.S.C. §103(a) as being obvious over Katz.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

The subject matter of the claims is summarized below with reference numerals and reference to the specification and drawings in accordance with 37 CFR §41.37.

Claim 9

The subject matter recited in claim 9 is directed to a computer-based method for presenting one or more promotions. In some embodiments a signal identifying a first product associated with an order is received in a computing system (page 14, lines 15-25), and a first product identifier which is associated with the first product (page 14, lines 15-25). When one or more promotions for at least a second product are associated with the first product identifier, the one or more promotions may be presented via a user interface (page 14, line 25-page 15, line 10; Fig 4, reference numerals 84-88).

Claim 17

The subject matter recited in claim 17 is directed to a computer program product comprising logic instructions stored on a computer-readable medium. When executed, the logic instructions configure a processor to present one or more products via a user interface (page 14, lines 15-25), receive a signal identifying a first product associated with an order (page 14, lines 15-25), associate a first product identifier with the first product (page 14, lines 15-25), and present, via the user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier (page 14, line 25-page 15, line 10; Fig 4, reference numerals 84-88).

Claim 23

The subject matter recited in claim 23 is directed to a computer-based method of delivering a promotional offer to a consumer. In some embodiments criteria for a promotional offer are stored in a computer-readable memory (page 11, lines 12-19; Fig. 1, reference numeral 18). A signal identifying a first product is associated with a consumer order (page 14, lines 15-25), and a first product identifier associated with the first product is compared with the criteria for a promotional offer (page 14, line 25-page 15, line 10; Fig 4, reference numeral 82). A promotional offer is presented in a user interface when the first product identifier corresponds to criteria for a promotional offer (page 14, line 25-page 15, line 10; Fig 4, reference numeral 92).

GROUNDΣ OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 9-23, 25, 26 and 28 are anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 6,055,513 to Katz.
2. Whether claims 24 and 27 are obvious under 35 U.S.C. §103(a) in view of Katz.

ARGUMENT

I. Rejections Under 35 U.S.C. §102

Claims 9-23, 25, 26, and 28 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,055,513 to Katz, et al (hereinafter, “Katz”). These rejections are traversed.

A. Legal Standard

The standard for lack of novelty, that is, for “anticipation,” under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991). Every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (finding that the jury had been erroneously instructed that anticipation may be shown by equivalents, a legal theory that is pertinent to obviousness under Section 103, not to anticipation under Section 102). “The identical invention must be shown in as complete detail as is contained in the patent claim.” MPEP §2131 (7th Ed. 1998) (citing *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Furthermore, functional language, preambles, and language in “whereby,” “thereby,” and “adapted to” clauses cannot be disregarded. *Pac-Tec, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990).

“It is by now well settled that the burden of establishing a *prima facie* case of

anticipation resides with the Patent and Trademark Office.” *Ex parte Skinner*, 2 USPQ2d 1788, 1788-1789 (Bd. Pat. Int. 1986) (holding that examiner failed to establish *prima facie* case of anticipation). The examiner has “the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103.” *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). Only if that burden is met, does the burden of going forward shift to the appellant.

B. Claims 9 and 17

The final Action fails to establish a *prima facie* case that Katz anticipates claim 9. Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131). Claim 9 is directed to a method for presenting one or more promotions and recites a first limitation directed to “receiving, in a computing system, a signal identifying a first product associated with an order.” The final action asserts that Katz discloses this limitation, and cites column 15, lines 38-65 and column 22, lines 31-45. Appellant disagrees. The cited text reads as follows:

FIG. 3 shows a block diagram of one implementation of a telemarketing system at a greater level of detail as compared to FIG. 2. While the following description is generally provided in the context of inbound telemarketing, the inventions herein may also equally be applied to outbound telemarketing. Users 74 (also known as customers, or potential customers) access the telemarketing system 40 via any known manner of telephone, telephonic instrument or its equivalent. As shown, telephone 76 comprises a touch-tone phone having a handpiece including a speaker and receiver, as well as an array of alphanumeric buttons for actuation by the customer 74. Alternatively, video phone 78 provides for both audio communication as well as image or video communication. The video phone 78 includes an array of alphanumeric buttons, a video display 80, typically a handset, and some imaging system 82, comprising a camera or other image generating system. A conventional touch-tone phone 76 may be utilized in association with a separate imaging system 84, if desired. In yet other modes, the customer or user 74 may interact with any other form of man-machine interface which is consistent with the goals and functionalities of these inventions. By way of example, but not of limitation, the customer 74 may interact with a computer, whether stand alone

or networked (by local area network (LAN), wide area network (WAN) or otherwise), which includes a communication capability (modem, etc.), or may comprise access capabilities to the Internet or web or internet television type systems.

The final aspect of the primary transaction is the completion or consummation of the primary transaction. In one implementation, the primary transaction may be completed, such as through consummation of a sale or completion of a service call or request. In yet other aspects, the primary transaction may be concluded, though not with the provision of the originally contemplated good or service. For example, in the context of a service contact, if the upsell is successful in providing the user with a replacement product, the primary transaction need not be completed. Optionally, at the caller's discretion, the primary transaction could be completed, such as where a caller does purchase a replacement product, but yet still wishes to obtain service on the product which form the basis for the original contact, and for the upsell.

Contrary to the assertion in the final Action, nothing in this text discloses (or even suggests) receiving, in a computing system, a signal identifying a first product associated with an order, as recited in claim 9. In the event the Examiner wishes to maintain the rejection, Appellant invites the examiner to point out with particularity what portions of the cited text correspond to the signal identifying a first product, as recited in the claim.

Claim 9 further recites “associating a first product identifier with the first product.” The final Action asserts that Katz discloses this limitation, and cites column 24, lines 31-49 to support the rejection. Appellant disagrees. The cited text reads as follows:

Other factors affecting the upsell may include inputs comprising areas of interest, such as based upon known subscriptions, prior contact of the user to other sites, such as other Internet sites may be utilized by the system to determine a user's possible interests, and therefore, their susceptibility to the upsell of particular goods or services. Yet another aspect of basing the upsell selection on prior purchases may include upgrades to prior purchases. For example, where the system determines that the user has previously purchased a computer of a given make and model, the system may offer as an upsell a good or service particularly adapted to improve the performance of the system of the user, such as provision of additional memory, or other modified component. Similarly, if a user is known to have a given version of software, the system may elect to offer a new version of the software. Obsolescence of prior purchases may be determined. This may be from the passage of time, updating of a product, or outgrowing of a prior purchase.

Contrary to the assertion in the final Action, nothing in this text discloses (or even

suggests) associating a first product identifier with the first product, as recited in claim 9. In the event the Examiner wishes to maintain the rejection, Appellant invites the examiner to point out with particularity what portions of the cited text correspond to associating a first product identifier with the first product, as recited in the claim.

Claim 9 further recites “presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier.” The final Action asserts that Katz discloses this limitation, and cites column 13, lines 27-51, column 17, line 37 to column 18, line 15, column 23, line 62 to column 25, line 55, and column 26, line 66 to column 27, line 21 to support the rejection. Appellant disagrees. The cited text reads as follows:

By way of terminology, when the terms "user", "system user", "customer", "potential customer", "contact" or equivalent terminology is used, those terms are meant to refer to a person or entity to whom the efforts of the offering are at least in part directed. Variations in meaning as to this terminology may be taken from context, as necessary. The terms "good(s)" and "service(s)" while distinct, are intended within the scope of the patent to be used interchangeably, where appropriate given the context. When appropriate from context, a good or service may include a coupon, ticket, card or other promotional material, including printed material, having a value designator. The term "upsell" means an offer or provision of a good or service which is selected for offer to the customer and differs from the good or service for which the primary contact was made. The term "upsell" is not limited to the context in which a primary transaction is intended to be a sales transaction, but additionally includes the offer of a good or service offered in accordance with the selection criteria of the invention even if the primary transaction is not principally sales motivated, such as where an initial contact is for service or repair purposes. The use of "he" is gender neutral, and may be read as "he", "she" or "it". When the term "and" or "or" is used, they may be read in the conjunctive or the disjunctive, where appropriate from context.

The depictions in FIG. 2 and FIG. 3 will be used now for a brief description of one mode of interaction of the customer 74 with the telemarketing system. A customer 74 may utilize a video phone 78 to dial a toll-free telephone number in response to observing a promotion for a good or service. The carrier 89 effects telephonic connection to the telemarketing system 40 preferably providing DNIS information which is utilized by the control unit 100 and local database 98 to provide a textual display on terminal 92 for use by the live operator 42 in interacting with the customer 74. Additionally, the carrier 89

may provide caller identification data, such as ANI data, which may be utilized by the control unit 100 to retrieve information from the database 98 particular to the customer 74. In addition to database 98, geographic designator programs exist which may be utilized to receive ANI data and to identify the geographic location of a customer such as by zip code, or more particularly, by zip code plus four. Based upon the retrieved information as provided to the live operator 42, a dialog is conducted relating to the primary transaction for which the customer 74 made the primary or initial contact with the system. While handling the primary transaction, the system may access one or more databases 50, such as a credit database 54 and a inventory database 56. If the user's credit card number has been obtained, such as during the primary transaction, or is otherwise known to the telemarketer through prior contacts or is devined via a correlation system, the credit card number may be utilized to obtain raw or analyzed data regarding the caller. The response from the credit card issuer or processor may be specific, such as providing data on the user's income, sex, history of purchase transactions or any other personal or demographic information known to it, or may provide a analyzed, coded message in response. The credit information, personal information, demographic information, possession information or other form of input data is then used by the system to generate the upsells or other real time provision of a secondary transaction. The secondary transaction may relate to the offer of a good or a service, or to a coupon, ticket, card or other promotional material having a variable or designated value for the purchase, lease or other acquisition in the future of a good or a service. In the preferred embodiment, there is a real time offer during a real time transaction. If the transaction is consummated, an indication may be provided to an order fulfillment unit 120 and attendant units such as the billing unit 122 and shipping/tracking unit 124.

Turning now to the upsell determination 340 or the selection of the product or service for offer, generally, the system comprises a multiple input, dynamic, preferably real-time system for the selection of a suggested product or service to offer to a potential customer or user. The process includes the identification or selection of a set or subset of all possible goods or services available for offer, with the goal of optimizing the likelihood of upsell, as well as achieving customer satisfaction.

In one aspect, the upsell determination system may utilize, in whole or in part, a system which bases the offer of an upsell based upon prior successful upsells. Thus, if a customer is categorized as being in class 422 who called a telemarketer to buy product X, and was successfully upsold product Y, if a later customer in class 422 contacts the system, the past success may be utilized as a factor in again offering the product Y to the caller.

Various historical factors relating to a specific customer, or to known classes of customers may be utilized. The selection criteria may include negative decision criteria, such as not trying to upsell a customer on an item that the system knows he has previously purchased, or has previously been offered but

declined to purchase. The system may utilize prior purchases as a factor in determining the upsell for offer. Prior purchases may indicate areas of interest, suggesting the offer of further goods within that general area of interest. For example, a customer who has previously purchased clothing for use in mountain biking may be more susceptible to an offer for mountain bike related goods or services. In a similar vein, theme sales may be utilized. When it is known that the customer has previously purchased a portion of a set, the completion of the set may be a goal. Certain theme sales are based on periodic introduction of a new item, such as a yearly addition of a tree ornament or the like.

Other factors affecting the upsell may include inputs comprising areas of interest, such as based upon known subscriptions, prior contact of the user to other sites, such as other Internet sites may be utilized by the system to determine a user's possible interests, and therefore, their susceptibility to the upsell of particular goods or services. Yet another aspect of basing the upsell selection on prior purchases may include upgrades to prior purchases. For example, where the system determines that the user has previously purchased a computer of a given make and model, the system may offer as an upsell a good or service particularly adapted to improve the performance of the system of the user, such as provision of additional memory, or other modified component. Similarly, if a user is known to have a given version of software, the system may elect to offer a new version of the software. Obsolescence of prior purchases may be determined. This may be from the passage of time, updating of a product, or outgrowing of a prior purchase.

Yet other facts affecting an upsell may include relative considerations. For example, relative proximity to key calendared dates 318 for the user, or others associated with the user, may be incorporated. The relationship of traditional gift giving days to the date of contact may be utilized. Examples would include proximity to known birth dates, Christmas, Hanukkah, anniversaries, Valentines Day, etc. Further, family or relationship status may be utilized, such as offers of products for purchase for children, grandchildren, or others with whom there is a known established relationship.

The frequency of the upsell may be varied based upon expected receptiveness to the upsell at that time. Certain users may, through past particular experience with that user or through assumed desirability based upon studies of others, may determine the frequency with which upsells should be offered, whether to offer an upsell every time there is a contact, every other time, only in association with certain days or date (such as pay days), etc. The frequency may also be decreased if the user has manifested a lack of receptiveness to the offers in the past, or to a certain type or class of offer.

Multiple upsell items 326 may be utilized. In the telemarketing context, the telemarketer may have displayed to them multiple options, either for selection by the telemarketer, or for sequential presentation to the caller. In the electronic commerce context, multiple offers may be made such as on a

screen, or provided sequentially to the caller.

The third main component of the upsell consists of the actual offer 350 of the upsell to the user. In the event of a telemarketing upsell offer, the typical mode would include a display on the telemarketers screen of various script or product information 354, which is then provided to the caller. FIG. 8 shows a representative screen for a telemarketer display. The display 270 may include script 272 for use by the telemarketer for interaction with the caller. Specific upsell scripts 274 may be provided, either as a single option for the telemarketer, or to provide multiple options for selection by the telemarketer. Soft keys or icons 276 provide for selective identification of entry by the telemarketer. Various text or numeric based fields 280, 282 may be provided for entry of information, such as order entry, and specifically including identification data 280 and address data 282. This data may be initially provided automatically from the system, for possible confirmation by the telemarketer, or may be initially input by the telemarketer. Optionally, if image information is provided during the transaction, image 278 may be depicted on the display 270. By way of example, if a video phone system is utilized, the image of the caller may be displayed. Additionally, or alternatively, if image or video is provided from the telemarketer to the customer, those images may also appear on the telemarketer's screen 270 in region 278 to provide the telemarketer the same (though possibly in reduced size such as a picture-in-picture) which is simultaneously being provided to the customer. An order entry icon, tab or button bar 284 may be utilized.

The mode or manner of the offer 352 to the customer may also be varied. The customer's prior history or a determined optimum mode or manner of offer based upon customer designation may be utilized. Certain customers or customer designations may be best offered the upsell in a business-like, straight-forward manner, e.g., "We have a special offer for you today . . . ". Other potential customers who have manifested less than an eagerness to be upsold in the past may be initially addressed with a message of an apologetic tone, e.g., "I know you to not typically consider other times, but we have something that we think you will find worth your time to consider . . . ". Yet other presentations may be in a more elaborate or flowery manner, such as in the addition of music, other audio, images, video. The coded designators, or other data regarding the user, may be used in determining the mode or manner of the offer.

FIG. 9 shows a highly simplified depiction of a display such as used in one implementation of a electronic commerce application utilizing the inventions of this system. The overall display 400 may include textual information 402 identifying the affiliation of the provider of the good or service. A graphical depiction 404 of the good or service may be provided, which is either a still image or includes motion. Information regarding features 406 may be provided as well as may be the terms 408 of sale, lease or other interchange. Optionally, a display 410 provides a video feed such as from a telemarketing or other operator assisting the user, or provides a created image regarding a

assistant for the transaction. Speakers 412 may be optionally utilized to provide audio information, either being one-way communication or two-way communication. Typically, some sort of a pointer 414 is displayed on screen 400 to designate the area of data for entry. For example, an acceptance 422 region may be clicked, or double clicked as required, to accept an offer. Optionally, an electronic coupon 420 or other form of coupon may be provided to the user in a real time manner for later use. The coupon may be for a discount on a later purchase, or may otherwise be a form of incentive to the customer, such as the award of credits which may be accumulated for exchange into other goods or services.

Contrary to the assertion in the final Action, nothing in this text discloses (or even suggests) presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier, as recited in claim 9. In the event the Examiner wishes to maintain the rejection, Appellant invites the examiner to point out with particularity what portions of the cited text correspond to presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier, as recited in the claim.

In sum, the final Action has failed to establish the factual evidence necessary to establish a *prima facie* case of anticipation of claim 9. Furthermore, Katz fails to disclose or suggest elements of claim 9, and therefore cannot anticipate claim 9.

Claim 17 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 17.

C. Claims 10 and 18

The final Action fails to establish a *prima facie* case that Katz anticipates claim 10. Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131). Moreover, the Examiner has “the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103.” *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Claim 10 recites limitations including “determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier.” The final Action asserts that Katz discloses this limitation, and cites column 23, line 62 to column 25, line 55 to support the rejection. Appellant disagrees. The cited text reads as follows:

Turning now to the upsell determination 340 or the selection of the product or service for offer, generally, the system comprises a multiple input, dynamic, preferably real-time system for the selection of a suggested product or service to offer to a potential customer or user. The process includes the identification or selection of a set or subset of all possible goods or services available for offer, with the goal of optimizing the likelihood of upsell, as well as achieving customer satisfaction.

In one aspect, the upsell determination system may utilize, in whole or in part, a system which bases the offer of an upsell based upon prior successful upsells. Thus, if a customer is categorized as being in class 422 who called a telemarketer to buy product X, and was successfully upsold product Y, if a later customer in class 422 contacts the system, the past success may be utilized as a factor in again offering the product Y to the caller.

Various historical factors relating to a specific customer, or to known classes of customers may be utilized. The selection criteria may include negative decision criteria, such as not trying to upsell a customer on an item that the system knows he has previously purchased, or has previously been offered but declined to purchase. The system may utilize prior purchases as a factor in determining the upsell for offer. Prior purchases may indicate areas of interest, suggesting the offer of further goods within that general area of interest. For example, a customer who has previously purchased clothing for use in mountain biking may be more susceptible to an offer for mountain bike related

goods or services. In a similar vein, theme sales may be utilized. When it is known that the customer has previously purchased a portion of a set, the completion of the set may be a goal. Certain theme sales are based on periodic introduction of a new item, such as a yearly addition of a tree ornament or the like.

Other factors affecting the upsell may include inputs comprising areas of interest, such as based upon known subscriptions, prior contact of the user to other sites, such as other Internet sites may be utilized by the system to determine a user's possible interests, and therefore, their susceptibility to the upsell of particular goods or services. Yet another aspect of basing the upsell selection on prior purchases may include upgrades to prior purchases. For example, where the system determines that the user has previously purchased a computer of a given make and model, the system may offer as an upsell a good or service particularly adapted to improve the performance of the system of the user, such as provision of additional memory, or other modified component. Similarly, if a user is known to have a given version of software, the system may elect to offer a new version of the software. Obsolescence of prior purchases may be determined. This may be from the passage of time, updating of a product, or outgrowing of a prior purchase.

Yet other facts affecting an upsell may include relative considerations. For example, relative proximity to key calendared dates 318 for the user, or others associated with the user, may be incorporated. The relationship of traditional gift giving days to the date of contact may be utilized. Examples would include proximity to known birth dates, Christmas, Hanukkah, anniversaries, Valentines Day, etc. Further, family or relationship status may be utilized, such as offers of products for purchase for children, grandchildren, or others with whom there is a known established relationship.

The frequency of the upsell may be varied based upon expected receptiveness to the upsell at that time. Certain users may, through past particular experience with that user or through assumed desirability based upon studies of others, may determine the frequency with which upsells should be offered, whether to offer an upsell every time there is a contact, every other time, only in association with certain days or date (such as pay days), etc. The frequency may also be decreased if the user has manifested a lack of receptiveness to the offers in the past, or to a certain type or class of offer.

Multiple upsell items 326 may be utilized. In the telemarketing context, the telemarketer may have displayed to them multiple options, either for selection by the telemarketer, or for sequential presentation to the caller. In the electronic commerce context, multiple offers may be made such as on a screen, or provided sequentially to the caller.

The third main component of the upsell consists of the actual offer 350 of the upsell to the user. In the event of a telemarketing upsell offer, the typical mode would include a display on the telemarketers screen of various script or

product information 354, which is then provided to the caller. FIG. 8 shows a representative screen for a telemarketer display. The display 270 may include script 272 for use by the telemarketer for interaction with the caller. Specific upsell scripts 274 may be provided, either as a single option for the telemarketer, or to provide multiple options for selection by the telemarketer. Soft keys or icons 276 provide for selective identification of entry by the telemarketer. Various text or numeric based fields 280, 282 may be provided for entry of information, such as order entry, and specifically including identification data 280 and address data 282. This data may be initially provided automatically from the system, for possible confirmation by the telemarketer, or may be initially input by the telemarketer. Optionally, if image information is provided during the transaction, image 278 may be depicted on the display 270. By way of example, if a video phone system is utilized, the image of the caller may be displayed. Additionally, or alternatively, if image or video is provided from the telemarketer to the customer, those images may also appear on the telemarketer's screen 270 in region 278 to provide the telemarketer the same (though possibly in reduced size such as a picture-in-picture) which is simultaneously being provided to the customer. An order entry icon, tab or button bar 284 may be utilized.

The mode or manner of the offer 352 to the customer may also be varied. The customer's prior history or a determined optimum mode or manner of offer based upon customer designation may be utilized. Certain customers or customer designations may be best offered the upsell in a business-like, straight-forward manner, e.g., "We have a special offer for you today . . . ". Other potential customers who have manifested less than an eagerness to be upsold in the past may be initially addressed with a message of an apologetic tone, e.g., "I know you to not typically consider other times, but we have something that we think you will find worth your time to consider . . . ". Yet other presentations may be in a more elaborate or flowery manner, such as in the addition of music, other audio, images, video. The coded designators, or other data regarding the user, may be used in determining the mode or manner of the offer.

Initially, Appellant notes that the final Action fails to point out with any particularity the manner in which the cited text discloses or suggests determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier, as recited in claim 10. Thus, the final Action has failed to establish the factual evidence necessary to establish a *prima facie* case of anticipation of claim 10.

Further, a review of the cited text reveals that, contrary to the assertion in the final

Action, nothing in this text discloses (or even suggests) associating a first product identifier with the first product, as recited in claim 10. In the event the Examiner wishes to maintain the rejection, Appellant invites the examiner to point out with particularity what portions of the cited text correspond to associating a first product identifier with the first product, as recited in the claim.

Claim 18 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 18.

D. *Claims 11 and 19*

The final Action fails to establish a *prima facie* case that Katz anticipates claim 11. Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131). Moreover, the Examiner has “the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103.” *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Claim 11 recites limitations including “comparing the first product identifier with a list of product identifiers associated with promotional offers.” The final Action asserts that Katz discloses this limitation, and cites column 23, line 62 to column 25, line 55 to support the rejection. Appellant disagrees. The cited text is excerpted above with reference to claim 10.

Initially, Appellant notes that the final Action fails to point out with any particularity the manner in which the cited text discloses or suggests comparing the first product identifier with a list of product identifiers associated with promotional offers, as recited in claim 11. Therefore, the Action fails to establish a *prima facie* case of anticipation.

Further, a review of the cited text reveals that, contrary to the assertion in the final Action, nothing in this text discloses (or even suggests) comparing the first product identifier with a list of product identifiers associated with promotional offers, as recited in claim 11. In the event the Examiner wishes to maintain the rejection, Appellant invites the examiner to point out with particularity what portions of the cited text correspond to comparing the first product identifier with a list of product identifiers associated with promotional offers, as recited in claim 11.

Claim 19 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 19.

E. Claim 12

The final Action fails to establish a *prima facie* case that Katz anticipates claim 12. Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131). Moreover, the Examiner has “the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103.” *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Claim 12 recites limitations including “wherein a promotion is associated with a combination of one or more product identifiers.” The final Action asserts that Katz discloses this limitation, and cites column 23, line 62 to column 25, line 55 to support the rejection. Appellant disagrees. The cited text is excerpted above with reference to claim 10.

Initially, Appellant notes that the final Action fails to point out with any particularity the manner in which the cited text discloses or suggests wherein a promotion is associated with a combination of one or more product identifiers, as recited in claim 12. Therefore, the

Action fails to establish a *prima facie* case of anticipation.

Further, a review of the cited text reveals that, contrary to the assertion in the final Action, nothing in this text discloses (or even suggests) an arrangement wherein a promotion is associated with a combination of one or more product identifiers, as recited in claim 12. In the event the Examiner wishes to maintain the rejection, Appellant invites the examiner to point out with particularity what portions of the cited text correspond to comparing the first product identifier with a list of product identifiers associated with promotional offers, as recited in claim 12.

F. *Claims 13 and 20*

The final Action fails to establish a *prima facie* case that Katz anticipates claim 13. Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131). Moreover, the Examiner has “the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103.” *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Claim 13 recites limitations including “presenting one or more replacement products in the user interface.” The final Action asserts that Katz discloses this limitation, and cites column 23, line 62 to column 25, line 55 to support the rejection. Appellant disagrees. The cited text is excerpted above with reference to claim 10.

Initially, Appellant notes that the final Action fails to point out with any particularity the manner in which the cited text discloses or suggests presenting one or more replacement products in the user interface, as recited in claim 13. Therefore, the Action fails to establish a *prima facie* case of anticipation.

Further, a review of the cited text reveals that, contrary to the assertion in the final Action, nothing in this text discloses (or even suggests) presenting one or more replacement products in the user interface, as recited in claim 13. In the event the Examiner wishes to maintain the rejection, Appellant invites the examiner to point out with particularity what portions of the cited text correspond to comparing the first product identifier with a list of product identifiers associated with promotional offers, as recited in claim 13.

Claim 20 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 20.

G. Claim 23

The final Action fails to establish a *prima facie* case that Katz anticipates claim 23. Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131). Claim 23 is directed to a computer-based method of delivering a promotional offer to a consumer and recites a first limitation directed to “storing criteria for a promotional offer in a computer-readable memory.” The final action asserts that Katz discloses this limitation, and cites column 15, lines 38-65 and column 22, lines 31-45. Appellant disagrees. The cited text reads as follows:

FIG. 3 shows a block diagram of one implementation of a telemarketing system at a greater level of detail as compared to FIG. 2. While the following description is generally provided in the context of inbound telemarketing, the inventions herein may also equally be applied to outbound telemarketing. Users 74 (also known as customers, or potential customers) access the telemarketing system 40 via any known manner of telephone, telephonic instrument or its equivalent. As shown, telephone 76 comprises a touch-tone phone having a handpiece including a speaker and receiver, as well as an array of alphanumeric buttons for actuation by the customer 74. Alternatively, video phone 78 provides for both audio communication as well as image or video communication. The video phone 78 includes an array of alphanumeric buttons, a video display 80, typically a handset, and some imaging system 82, comprising a camera or other image generating system. A conventional touch-tone phone 76 may be utilized in association with a separate imaging system 84, if desired. In yet other modes, the customer or user 74 may interact with any other form of man-machine interface which is consistent with the goals

and functionalities of these inventions. By way of example, but not of limitation, the customer 74 may interact with a computer, whether stand alone or networked (by local area network (LAN), wide area network (WAN) or otherwise), which includes a communication capability (modem, etc.), or may comprise access capabilities to the Internet or web or internet television type systems.

The final aspect of the primary transaction is the completion or consummation of the primary transaction. In one implementation, the primary transaction may be completed, such as through consummation of a sale or completion of a service call or request. In yet other aspects, the primary transaction may be concluded, though not with the provision of the originally contemplated good or service. For example, in the context of a service contact, if the upsell is successful in providing the user with a replacement product, the primary transaction need not be completed. Optionally, at the caller's discretion, the primary transaction could be completed, such as where a caller does purchase a replacement product, but yet still wishes to obtain service on the product which form the basis for the original contact, and for the upsell.

Contrary to the assertion in the final Action, nothing in this text discloses (or even suggests) storing criteria for a promotional offer in a computer-readable memory, as recited in claim 23. In the event the Examiner wishes to maintain the rejection, Appellant invites the examiner to point out with particularity what portions of the cited text correspond to storing criteria for a promotional offer in a computer-readable memory, as recited in the claim.

Claim 23 further recites “receiving, in a computing system, a signal identifying a first product associated with a consumer order.” The final Action asserts that Katz discloses this limitation, and cites column 13, lines 27-51, column 17, line 37 to column 18, line 15, column 23, line 62 to column 25, line 55 and column 26, line 66 to column 27, line 21. The cited text is excerpted above, with reference to claim 9.

Initially, Appellant notes that the final Action fails to point out with any particularity the manner in which the cited text discloses or suggests receiving, in a computing system, a signal identifying a first product associated with a consumer order, as recited in claim 23. Therefore, the Action fails to establish a *prima facie* case of anticipation.

Further, a review of the cited text reveals that, contrary to the assertion in the final

Action, nothing in this text discloses (or even suggests) receiving, in a computing system, a signal identifying a first product associated with a consumer order, as recited in claim 23. In the event the Examiner wishes to maintain the rejection, Appellant invites the examiner to point out with particularity what portions of the cited text correspond to receiving, in a computing system, a signal identifying a first product associated with a consumer order, as recited in claim 23.

Claim 23 further recites “comparing a first product identifier associated with the first product with the criteria for a promotional offer.” The final Action asserts that Katz discloses this limitation, and cites column 13, lines 27-51, column 17, line 37 to column 18, line 15, column 23, line 62 to column 25, line 55 and column 26, line 66 to column 27, line 21. The cited text is excerpted above, with reference to claim 9.

Initially, Appellant notes that the final Action fails to point out with any particularity the manner in which the cited text discloses or suggests comparing a first product identifier associated with the first product with the criteria for a promotional offer, as recited in claim 23. Therefore, the Action fails to establish a *prima facie* case of anticipation.

Further, a review of the cited text reveals that, contrary to the assertion in the final Action, nothing in this text discloses (or even suggests) comparing a first product identifier associated with the first product with the criteria for a promotional offer, as recited in claim 23. In the event the Examiner wishes to maintain the rejection, Appellant invites the examiner to point out with particularity what portions of the cited text correspond to comparing a first product identifier associated with the first product with the criteria for a promotional offer, as recited in claim 23.

Claim 23 further recites “presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer.” The final Action

asserts that Katz discloses this limitation, and cites column 13, lines 27-51, column 17, line 37 to column 18, line 15, column 23, line 62 to column 25, line 55 and column 26, line 66 to column 27, line 21. The cited text is excerpted above, with reference to claim 9.

Initially, Appellant notes that the final Action fails to point out with any particularity the manner in which the cited text discloses or suggests presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer, as recited in claim 23. Therefore, the Action fails to establish a *prima facie* case of anticipation.

Further, a review of the cited text reveals that, contrary to the assertion in the final Action, nothing in this text discloses (or even suggests) presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer, as recited in claim 23. In the event the Examiner wishes to maintain the rejection, Appellant invites the examiner to point out with particularity what portions of the cited text correspond to presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer, as recited in claim 23.

In sum, the final Action has failed to establish the factual evidence necessary to establish a *prima facie* case of anticipation of claim 23. Furthermore, Katz fails to disclose or suggest elements of claim 23, and therefore cannot anticipate claim 23.

Claim 26 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 26.

II. Rejections Under 35 U.S.C. §103

Claims 24 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Katz. Appellant traverses this rejection, and asserts that the final Action fails to establish a *prima facie* case of obviousness.

A. Legal Standard for Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all* the claim limitations. (*See, MPEP 2143*). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As with anticipation, the Examiner bears the burden of proof to provide a factual basis to support a rejection under 35 U.S.C. §103. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). Only if that burden is met, does the burden of going forward shift to the appellant.

B. *Claims 24 and 27*

The final Action fails to establish a *prima facie* case that Katz renders obvious claim 24. There is *no evidence of record whatsoever* to support the assertion in the final Action that claims 24 is obvious.

The Action acknowledges that Katz fails to disclose associating a product identifier with one or more promotional codes, as recited in claim 24. The Action asserts that it would have been obvious to modify the method taught by Katz with the use of promotional codes “since it was known in the art that promotions are identified by codes to provide a way of tracking the promotions.” However, the Action fails to cite any references to support the assertion of obviousness or to assert Official Notice. In sum, there is no evidence of record to support the assertion. Therefore, the rejection is improper and must be withdrawn. (See MPEP 2144.03).

Claim 27 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 27.

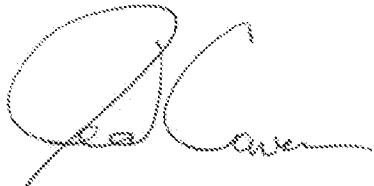
CONCLUSIONS

The final Action fails to provide an evidentiary record sufficient to support an anticipation rejection of claims 9-23, 25, 26 and 28 under 35 U.S.C. §102. Therefore, Appellant urges the Board to reverse the examiner's rejections under 35 U.S.C. §102 of claims 9-23, 25, 26 and 28.

Further, the final Action fails to provide an evidentiary record sufficient to support an obviousness rejection of claims 24 and 27 under 35 U.S.C. §103. Therefore, Appellant urges the Board to reverse the examiner's rejections under 35 U.S.C. §103 of claims 24 and 27.

Respectfully submitted,

Jed W. Caven
Caven & Aghevli LLC
Attorney for Appellants

A handwritten signature in black ink, appearing to read "Jed W. Caven".

By:
Jed W. Caven
Registration No. 40,551
(720) 841-9544

Date: December 1, 2006

APPENDIX A

Claims

9. A computer-based method for presenting one or more promotions, comprising:
 - receiving, in a computing system, a signal identifying a first product associated with an order;
 - associating a first product identifier with the first product;
 - presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier.
10. The method of claim 9, wherein presenting, via a user interface, one or more promotions comprises determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier.
11. The method of claim 10, wherein determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier comprises comparing the first product identifier with a list of product identifiers associated with promotional offers.
12. The method of claim 9, wherein a promotion is associated with a combination of one or more product identifiers.
13. The method of claim 9, further comprising presenting one or more replacement products in the user interface.
14. The method of claim 9, further comprising receiving, in the computing system, a signal requesting processing for one or more promotions.
15. The method of claim 14, further comprising replacing the first product with the second product when a replacement promotion is selected.

16. The method of claim 14, further comprising adding another product to the order when an enhancement promotion is selected.

17. A computer program product comprising logic instructions stored on a computer-readable medium which, when executed, configure a processor to:
 - present one or more products via a user interface;
 - receive a signal identifying a first product associated with an order;
 - associate a first product identifier with the first product;
 - present, via the user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier.
18. The computer program product of claim 17, further comprising logic instructions which, when executed, configure the processor to determine, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier.
19. The computer program product of claim 18, further comprising logic instructions which, when executed, configure the processor to compare the first product identifier with a list of product identifiers associated with promotional offers.
20. The computer program product of claim 17, further comprising logic instructions which, when executed, configure the processor to present one or more replacement products in the user interface.
21. The computer program product of claim 17, further comprising logic instructions which, when executed, configure the processor to:
 - receive, in the computing system, a signal requesting processing for one or more promotions;
 - replace the first product with the second product when a replacement promotion is selected.

22. The computer program product of claim 17, further comprising logic instructions which, when executed, configure the processor to:

receive, in the computing system, a signal requesting processing for one or more promotions; and

add another product to the order when an enhancement promotion is selected.

23. A computer-based method of delivering a promotional offer to a consumer, comprising:
- storing criteria for a promotional offer in a computer-readable memory;
 - receiving, in a computing system, a signal identifying a first product associated with a consumer order;
 - comparing a first product identifier associated with the first product with the criteria for a promotional offer; and
 - presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer.
24. The method of claim 23, wherein storing criteria for a promotional offer in a computer-readable memory comprises associating the first product identifier with one or more promotional codes.
25. The method of claim 23, further comprising:
- receiving, in the computing system, a signal requesting processing for one or more promotions;
 - replacing the first product with the second product when a replacement promotion is selected; and
 - adding another product to the order when an enhancement promotion is selected.

26. A computer program product comprising logic instructions stored on a computer-readable medium which, when executed, configure a processor to:
- store criteria for a promotional offer in a computer-readable memory;
 - receive, in a computing system, a signal identifying a first product associated with a consumer order;
 - compare a first product identifier associated with the first product with the criteria for a promotional offer; and
 - present a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer.
27. The computer program product of claim 26, further comprising logic instructions which, when executed, configure the processor to associate a product identifier with one or more promotional codes.
28. The computer program product of claim 26, further comprising logic instructions which, when executed, configure the processor to:
- receive, in the computing system, a signal requesting processing for one or more promotions;
 - replace the first product with the second product when a replacement promotion is selected; and
 - add another product to the order when an enhancement promotion is selected.

Evidence Appendix

None

Related Proceedings Appendix

None